

REMARKS

In the final Office Action dated June 17, 2003, in response to an Amendment filed on March 20, 2003 and the Applicants' argument that the cited Rhodes referenced "teaches away from any self-expanding device," the Examiner relied upon MPEP 2145 as stating: "a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." Claims 22-24, 27 and 30-32 were then rejected under 35 U.S.C. §103(a) as being unpatentable over Lazarus, et al. (5,275,622) in view of Rhodes (5,122,154) and claims 22, 25, 26, 28 and 29 were rejected under 35 U.S.C. §103(a) as being upatentable over Rhodes in view of Lazarus, et al.

The Applicants have acknowledged the Examiner's reliance upon MPEP 2145 in the outstanding final Office action. It is to be recognized that MPEP 2145 while referencing MPEP 2143.01, also states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine referenced teachings. It is additionally noted that MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" and that "A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." Further, the MPEP states that "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." Moreover, it is highly significant that MPEP 2143.01 also states that "If the proposed

modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."

In view of the same, it is respectfully submitted that combining the Rhodes and Lazarus references under Section 103 is improper because there is no motivation for the combination. It is particularly improper when the teachings of the Rhodes reference is modified by the teachings of the Lazarus reference (See rejection of claims 22, 25, 26, 28 and 29) as Rhodes is specifically concerned with avoiding the shortcomings of self-expanding structures and, therefore, modifying Rhodes in view of Lazarus "would change the principal operation of the prior art invention being modified." With respect to claims 25 and 26, for example, the combination of teachings employed in the outstanding Office action requires Rhodes to be modified to incorporate a plurality of frames, each of which are self-expanding, which is, in fact, the very characteristic Rhodes seeks to avoid. Therefore, it is believed that the pending claims are patentable over the cited art.

CONCLUSION

Applicants have attempted to respond to each and every rejection set forth in the outstanding Office Action. In view of the above amendments and remarks, Applicants respectfully request that the application be reconsidered, the claims allowed, and the application passed to issue.

Respectfully submitted,

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